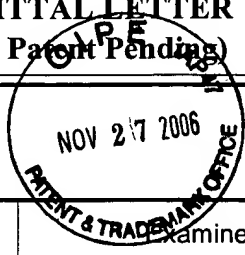


TRANSMITTAL LETTER
(General - Patent Pending)

Docket No.
JEL31040

In Re Application Of: Jose FEDIDA



Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/526,547	March 16, 2000	V. Bui	24257	3734	1825

Title: **STRUCTURE OF A PROSTHESIS INTENDED TO BE IMPLANTED IN A HUMAN OR ANIMAL PASSAGE AND PROSTHESIS WITH SUCH A STRUCTURE**

COMMISSIONER FOR PATENTS:

Transmitted herewith is:

a Supplemental Reply Brief

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THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Appeals and Interferences

In re the Application of

Inventors: Jose FEDIDA

Appln No.: 09/526,547

Filed: March 16, 2000

For: STRUCTURE OF A PROSTHESIS INTENDED TO BE IMPLANTED
IN A HUMAN OR ANIMAL PASSAGE AND PROSTHESIS WITH
SUCH A STRUCTURE

SUPPLEMENTAL REPLY BRIEF

On Appeal From Group Art Unit 3734

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TABLE OF CONTENTS

A.	Rejection of Claims 18, 19, 22, 26, 27, 29, 30, 33, 37, and 38 as Being Anticipated by Goicoechea.	3
1.	Goicoechea fails to disclose the claimed links having a sole central portion and two loops, one loop at each of the ends of the central portion, whereby each of the two loops entraps a respective one of two corrugations that are to be linked together.	4
2.	Goicoechea fails to disclose the claimed feature whereby each link loop provides clearance between the entrapped corrugation and the loop.	7
B.	Rejection of Claims 18, 19, 22, 26, 27, 29, 30, 33, 37, and 38 as Being Obvious over Goicoechea.	8
C.	Miscellaneous Issues.	10

TABLE OF AUTHORITIES

Manual of Patent Examining Procedure, Eighth Edition, August 2006, §2144.08 (II) (A)	9
Manual of Patent Examining Procedure, Eighth Edition, August 2006, §2131	4
Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987)	4

REMARKS

This Supplemental Reply Brief is a supplement to Appellant's Reply Brief and Appeal Brief in that it addresses specific arguments presented in the Examiner's Supplemental Answer, dated October 24, 2006, (hereinafter "ESA"). The arguments presented herein supplement those presented in the Reply Brief and Appeal Brief, but do not replace them.

Claims 18, 19, 22, 26, 27, 29, 30, 33, 37, and 38 stand rejected, under 35 USC §102(b), as being anticipated by or in the alternative, under 35 USC § 103(a), as being unpatentable over Goicoechea et al. (US 5,609,627). Claims 23, 28, 34, and 39 stand rejected, under 35 USC § 103(a), as being unpatentable over Goicoechea. Claims 21, 24, 25, 32, 35, and 36 stand rejected, under 35 USC § 103(a), as being unpatentable over Goicoechea in view of Lau et al. (US 5,873,906).

A. Rejection of Claims 18, 19, 22, 26, 27, 29, 30, 33, 37, and 38 as Being Anticipated by Goicoechea.

Independent claim 18 recites:

A structure of a prosthesis ... comprising:
... links which are made as a rigid piece,
wherein each of said links is provided with a sole central portion and two loops, one loop at each of the ends of said central portion,
...

wherein each of the two closed loops of each of said links entraps, in said linking position, with some

clearance, a respective one of two of said corrugations, which are to be linked together.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131.

1. Goicoechea fails to disclose the claimed links having a sole central portion and two loops, one loop at each of the ends of the central portion, whereby each of the two loops entraps a respective one of two corrugations that are to be linked together.

The ESA proposes that because a staple inherently has a central portion and a loop at each end of the central portion that entraps a separate element to be linked by the staple, Goicoechea's disclosed staple 99e must necessarily have these features, even though Goicoechea does not expressly describe them (see ESA page 3, second paragraph, second sentence). The ESA further expounds upon this description of a staple by stating that the two loops of the staple inherently cannot entrap the same elements (see page 3, second paragraph, last sentence ("[the] two loops of [Goicoechea's] staple 99e must each receive one of two opposing wire[s] and one loop of [the] staple will not receive both opposing apices of the stent wire shown in Goicoechea-627's Fig. 4F)).

As an example of a staple having the ESA's proposed inherent characteristics, the ESA submits into evidence a staple 82 illustrated in Graf's (US 3,751,961) Figs. 8 and 9. The ESA states that staple 82 links wire 88 and wire 92 (see ESA page 3, lines 3-4). As may be seen by inspection of Graf's Figs. 8 and 9, staple 82 does entrap a separate element (e.g., wire) in each loop, thereby comporting with the ESA's proposed inherent characteristics for a staple.

However, the ESA identifies two other staples that do not have the proposed inherent characteristics for a staple. Specifically, the ESA identifies a staple for keeping sheets of paper together in an office environment (see ESA, sentence bridging pages 2 and 3) and the staple illustrated in Contra et al. (US 4,304,236) Figs. 21 and 22 (see ESA page 3, lines 3-5). Clearly, a paper staple does not entrap a separate piece of paper in each of two loops connected by a central portion such that neither loop entraps both sheets of paper (see Appellant's Appeal Brief for a further description of how a paper staple may bind multiple sheets of paper). And as may be determined by examination of Contra's Figs. 21 and 22, elements 300 and 302 are both entrapped by the loops of staple 159.

Thus, a staple does not inherently have the characteristics proposed in the ESA. More specifically, a staple does not

inherently entrap a separate element within each loop such that no element is entrapped by more than one loop. Accordingly, Appellant submits that since a staple does not inherently have the characteristics proposed in the ESA, it follows that Goicoechea does not inherently disclose such a staple merely because the word staple is recited in Goicoechea's specification.

Moreover, Goicoechea expressly discloses that staple 99e does not have the characteristics the ESA proposes are inherent to a staple. Goicoechea's discloses, in Fig. 4F, a wire that secures an apex 22 of one hoop 20 to a juxtaposed apex 22 of a neighboring hoop 20 and that this wire may be a staple 99e (see Goicoechea col. 9, lines 43-50 and 58-61). Thus, as illustrated in Goicoechea's Fig. 4F and described in the specification, Goicoechea discloses that staple 99e is a wire that forms a single closed loop circuit surrounding two hoops 20 (see Appeal Brief for a more detailed discussion of this feature).

In accordance with the above discussion, Appellant submits that Goicoechea neither expressly nor inherently discloses the claimed links having a sole central portion and two loops, one loop at each of the ends of the central portion, whereby each of the two loops entraps a respective one of two corrugations that are to be linked together. Independent claim 29 similarly recites this feature. Therefore, reversal of the anticipation

rejections and allowance of claims 18 and 29 and all claims dependent therefrom is warranted.

Appellant notes, for thoroughness, that the rationale identified in the ESA for making a staple in a particular way based on its use within a blood vessel (see ESA page 3, second paragraph, penultimate sentence) does not make a proposed characteristic of the staple any more or less inherent, as seemingly proposed in the ESA. A characteristic of a device is either inherent or it is not. An identified use of the device or a rationale explaining why the device might have a particular characteristic for the identified use does not change whether the characteristic is inherent.

2. Goicoechea fails to disclose the claimed feature whereby each link loop provides clearance between the entrapped corrugation and the loop.

Independent claims 18 and 29 recite providing clearance between each link loop and the corrugation entrapped by the loop. The ESA proposes that "it would have been obvious to one of ordinary skill in the art to provide some clearance ... to allow relative movement between the staple's loops and [the] two opposing apices of ... stent wire and make the stent flexible" (see ESA section I(2), third paragraph, last sentence).

Appellant respectfully submits that the obviousness of a motivation to modify a structure cannot serve as the basis for a finding of anticipation, irrespective of whether the obviousness actually exists. A finding of anticipation is supported only where a prior art reference identically discloses the claimed subject matter, not where a motivation may exist for modifying the prior art.

Accordingly, reversal of the anticipation rejections and allowance of claims 18 and 29 and all claims dependent therefrom is warranted for this independent reason.

B. Rejection of Claims 18, 19, 22, 26, 27, 29, 30, 33, 37, and 38 as Being Obvious over Goicoechea.

As an alternative to its proposal that Goicoechea inherently discloses the claimed feature discussed in section A(1) above, the ESA proposes that such a feature is "well known" and it would have been obvious to one of ordinary skill in the art at the time of Appellant's invention to link two opposing apices of the stent wire illustrated by Goicoechea in the manner recited in Appellant's independent claims (see ESA page 3, last paragraph). Appellant disagrees.

A finding of obviousness may only arise where the evidence of record provides a motivation or an express teaching to modify

a prior art device to achieve the claimed subject matter. See MPEP §2144.08(II)(A). The ESA does not propose that such evidence exists. Instead, the ESA merely proposes that a claimed feature would have been well known to a skilled artisan at the time of Appellant's invention. However, evidence that one or even all of the claimed features were well known at the time of the invention, standing alone, cannot support a finding of obviousness.

Accordingly, since the ESA does not identify any evidence of a motivation or an express teaching to modify Goicoechea's structure to achieve the claimed subject matter, the evidence cannot support a finding of obviousness. Therefore, reversal of the obviousness rejections applied to independent claims 18 and 29 and allowance of these claims and all claims dependent therefrom is warranted.

Furthermore, since Goicoechea does not teach a prosthesis structure having the claimed feature discussed in section A(1) above, it necessarily follows that Goicoechea cannot provide a motivation or suggestion to modify this feature to provide clearance between the claimed link loops and the secured corrugations as described in section A(2). The ESA proposes that it would have been obvious to modify Goicoechea's staple 99e such

that its loops allow movement between the loops and the secured stent wires (see ESA section I(2), last four lines).

However, as discussed above, Goicoechea's staple 99e is different from the claimed links. Thus, the proposed obviousness of modifying Goicoechea's staple 99e to provide clearance for a secured object, standing alone, does not provide a motivation to modify a link similar to the claimed link.

Accordingly, Appellant submits that Goicoechea does not render obvious the subject matter defined by independent claims 18 and 29 for this independent reason. Therefore, reversal of the rejections applied to claims 18 and 29 and allowance of these claims and all claims dependent therefrom is warranted.

C. Miscellaneous Issues.

Section I(3) of the ESA repeats the arguments presented in section I(2), without raising a new issue. Thus, Appellant's remarks presented in section B, above, fully address these arguments.

Section I(4) of the ESA identifies staples that do and staples that do not have the characteristics identified in section I(1) of the ESA as being inherent to a staple. Thus, section I(4) seems to support Appellant's remarks presented in section A(1), above.

The arguments presented in section II of the ESA are addressed in sections A and B above.

The ESA proposes in several places that Appellant made admissions in the Reply Brief (see, for example, ESA page 4, first and third paragraphs, and page 5, second and last paragraphs). In section I(2), first paragraph, for instance, the ESA proposes that Appellant admitted on page 5, second paragraph, of the Reply Brief that an endoluminal prosthesis must be flexible for its deployment along a tortuous path of blood vessels. However, Appellant actually stated in the Reply Brief that "the Examiner's Answer acknowledges that such a prosthesis must be flexible for its deployment along a tortuous path of blood vessels (Examiner's Answer page 7, third paragraph, first sentence). In light of Goicoechea's disclosure and the [examiner's acknowledged] requirement of flexibility, it is clear that conventional staples used in a conventional office stapler are unsuitable for insertion into aortic arteries or are flexible enough for deployment through a tortuous path of blood vessels, contrary to the proposal in the Examiner's Answer."

Thus, as may be determined from the quoted portion of Appellant's Reply Brief, Appellant identified a feature the Examiner's Answer acknowledged to be a requirement for a prosthesis. A statement made by the Patent and Trademark Office


does not create an admission on the part of Appellant, and identifying a statement made by the Patent and Trademark Office, as Appellant did in the Reply Brief, also does not give rise to an admission on the part of Appellant. The other admissions proposed in the ESA are similarly fallacious.

In view of the law and facts stated herein, it is respectfully submitted that all pending claims define patentable subject matter. Therefore, reversal of all outstanding grounds of the objections and rejections is respectfully solicited.

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